

Case No. 130237-2

REMARKS

Claims 1 – 19 are pending in the present Application. Claims 2, 11 and 12 have been canceled and Claims 1, 3, 4, 7 - 10 and 17 - 19 have been amended, leaving Claims 1, 3 – 10 and 13 - 19 for consideration upon entry of the present Amendment. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Applicants also like to thank the Examiner for the interview granted on July 7th, 2005. A declaration has been forwarded herewith that contains results pertaining to those requested during the interview.

Amended Claims

Claims 1, 3, 4, 10 and 17 - 19 have been amended to better define the invention. Support for the amendment to these claims can be found in Claim 12 as originally filed.

Claims 7 and 8 have been amended to provide the proper antecedent basis and to correct for typographical errors. These amendments were not made to overcome any cited references.

Claims 9, 10 and 19 were amended to correct for typographical errors.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1 – 10, 13, 14 and 16 – 19 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over WO 02/32999 to Van Hammersveld in view of U.S. Patent No. 5,849,822 to Kido et al. (Kido) or U.S. Patent No. 5,574,104 to Kolycheck et al. (Kolycheck) (Office Action dated 03/29/2005, page 2). Applicants respectfully traverse this rejection.

In making the rejection, the Examiner has stated that "Van Hammersveld does literally teach that the antistatic agent should have an index of refraction matching that of the remaining composition, however such a match can be inferred from the teaching that fillers should have a matching index of refraction" (Office Action dated 03/29/2005, page 2).

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are

Case No. 130237-2

disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The claimed invention is directed to a transparent permanent electrostatic dissipating composition comprising a transparent aromatic polycarbonate resin, a miscible transparent cycloaliphatic copolyester, and a sufficient amount of a polyetheresteramide polymer for imparting electrostatic dissipative properties to the composition, wherein the index of refraction of the electrostatic dissipating polymer lies between the refractive index of the polycarbonate resin and that of the cycloaliphatic copolyester resin, and wherein the weight ratio of cycloaliphatic copolyester to polycarbonate is from about 2.0 to about 1.6. (Claim 1) Van Hammersveld

Van Hammersveld discloses a non-opaque thermoplastic alloy comprising a continuous phase and a discontinuous phase wherein the discontinuous phase is immiscible with the continuous phase (see Abstract). The continuous phase is preferably polycarbonate and the discontinuous phase is preferably transparent ABS (see Abstract). Van Hammersveld teaches that the continuous phase can utilize a mixture of polycarbonate and PCCD, wherein the relative amounts of the polycarbonate and the PCCD are controlled in a manner effective to maintain a transparent continuous phase (page 9, lines 10 – 25). Van Hammersveld, however, does not teach a weight ratio of cycloaliphatic copolyester to polycarbonate from about 2.0 to about 1.6, as is presently claimed.

Table 2 in the present application clearly shows that while the ratio of polycarbonate and the PCCD can be controlled to produce a transparent continuous phase (see Experiment C4 in Table 2), the addition of the antistatic agent to the continuous phase produces a high level of haze (see Experiment C5 – C9 in Table 2). However, when the weight ratio of cycloaliphatic copolyester to polycarbonate is maintained from about 2.0 to about 1.6, the addition of an antistatic agent produces very little haze (see Table 1 in the application).

Case No. 130237-2

Applicants would also like to point the Examiner to Table 1 in the Declaration where it can be seen that there is a reduction over 100% in haze when the weight ratio of PCCD to PC is between 1.6 and 2.0. From Table 1 it can clearly be seen that the haze increases drastically when the weight ratio of PCCD to PC lies outside the range of 1.6 and 2.0.

Thus maintaining a weight ratio of copolyester to polycarbonate of about 2.0 to about 1.6 produces advantageous results and this is neither suggested nor disclosed by Van Hammersveld. For this reason at least, Van Hammersveld does not teach all elements of the claimed invention.

Kido

Kido discloses a thermoplastic resin composition of the present invention comprises a thermoplastic resin (A) and a polyether ester (B) (see Abstract). While, Kido teaches that the thermoplastic resin (A) has a refractive index of 1.52 to 1.61 and a haze of 40% or less (Col. 4, lines 28 – 30), it does not teach an antistatic composition comprising a weight ratio of copolyester to polycarbonate of about 2.0 to about 1.6 as presently claimed. For this reason at least Kido does not make up for the deficiency of Van Hammersveld and the combination of Kido with Hammersveld would not teach all elements of the claimed invention.

Kolycheck

Kolycheck discloses electrostatic dissipative polymeric compositions comprising a polyether polyurethane that can be blended with one or more base polymers (see Abstract). While Kolycheck does teach blends of polymers (see Claim 1), it, like Kido, specifically does not disclose or suggest an antistatic composition comprising a weight ratio of copolyester to polycarbonate of about 2.0 to about 1.6 as presently claimed. For this reason at least Kolycheck does not make up for the deficiency of Van Hammersveld and the combination of Kolycheck with Hammersveld would not teach all elements of the claimed invention.

In addition, there is no motivation for one of ordinary skill in the art to combine Van Hammersveld with either Kido or Kolycheck. Since neither Van Hammersveld, Kido nor Kolycheck teach a weight ratio of copolyester to polycarbonate of about 2.0 to about 1.6, one of ordinary skill in the art would not find any motivation to combine them.

Additionally, there would be no expectation of success in combining Van Hammersveld

Case No. 130237-2

with Kido or Kolycheck. As indicated above, the experimental section of the present application shows experiments where the various weight ratios of PCCD with polycarbonate reveal that only those ratios between 2.0 and 1.6 are effective in producing transparent antistatic compositions. All other ratios produce high haze. Table 1 in the declaration confirms this result. These results are unexpected. In this connection, the courts have held that “[a]n applicant can rebut a prima facie case of obviousness by presenting comparative test data showing that the claimed invention possesses unexpectedly improved properties or properties that the prior art does not have.” *In re Dillon*, 919 F.2d 688, 692-93, 16 U.S.P.Q.2d 1987, 1901 (Fed. Cir. 1990).

In summary, since the combination of Van Hammersveld with Kido or Kolycheck does not teach all elements of the claimed invention and since comparative testing produces unexpected results, Applicants respectfully request a withdrawal of the § 103 rejection and an allowance of the claims.

Claims 1 – 14 and 16 – 19 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over WO 02/32999 to Van Hammersveld in view of U.S. Patent No. 5,604,284 to Ueda et al. (Ueda) or U.S. Patent No. 6,706,851 to Linemann et al. (Linemann) (Office Action dated 03/29/2005, page 3). Applicants respectfully traverse this rejection.

Van Hammersveld

As noted above, Van Hammersveld does not teach all elements of the claimed invention. In particular, Van Hammersveld fails to teach an antistatic composition comprising a weight ratio of copolyester to polycarbonate of about 2.0 to about 1.6 as is presently claimed.

Ueda

Ueda discloses polyetheresteramides that having good heat resistance, permanent antistatic properties and superior compatibility with thermoplastic resins (see Abstract). While Ueda teaches a large number of thermoplastic resins that can be blended with the polyetheresteramides (see Col. 5, line 16 – Col. 6, line 56), Ueda, like Van Hammersveld, Kido and Kolycheck, does not teach a weight ratio of copolyester to polycarbonate of about 2.0 to about 1.6 as is presently claimed. Thus Ueda does not make up for the deficiency of

Case No. 130237-2

Van Hammersveld and a combination of Ueda with Van Hammersveld would not produce the claimed invention.

Linemann

Linemann discloses antistatic or breathable polymer compositions comprising a thermoplastic polymer and polyetheresteramides (see Abstract). Linemann, like Ueda does not teach a weight ratio of copolyester to polycarbonate of about 2.0 to about 1.6 as is presently claimed. Thus Linemann does not make up for the deficiency of Van Hammersveld and a combination of Linemann with Van Hammersveld would not produce the claimed invention.

In addition, there would be no motivation to combine Van Hammersveld with either Ueda or Linemann since none of the three references provide any suggestion that specific weight ratios of copolyester to polycarbonate can produce superior transparency over other compositions that do not contain these ratios.

As noted above, since neither Van Hammersveld, Ueda nor Linemann disclose antistatic compositions having weight ratios of copolyester to polycarbonate of about 2.0 to about 1.6 as is presently claimed, there would be no expectation of success in combining the references. As detailed above, there is a synergistic combination of polyetheresteramides with copolyester-polycarbonate blends when the copolyester to polycarbonate weight ratio is about 2.0 to 1.6. This synergy produces antistatic compositions that have significantly higher transparency than other combinations of copolyester to polycarbonate that lie outside this ratio. These results are therefore unexpected. Applicants therefore respectfully request the Examiner to withdraw the § 103 rejection over Van Hammersveld with Ueda or Linemann.

Claims 1 – 10 and 13 – 19 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over WO 99/63002 to Hoefflin or WO 02/38675 to Gaggar in view of U.S. Patent No. 5,849,822 to Kido et al. (Kido) or U.S. Patent No. 5,574,104 to Kolycheck et al. (Kolycheck) (Office Action dated 03/29/2005, page 3). Applicants respectfully traverse this rejection.

Case No. 130237-2

Hoefflin

Hoefflin teaches a thermoplastic resin comprising a miscible resin blend of a ductile resin containing greater than about 60 percent by weight repeating units of an aryl polycarbonate, and a polyester resin wherein ratio of polyester resin to ductile resin is from about 60 to 40 to about 85 to about 15 (see Abstract). Hoefflin teaches that the miscible resin blend has a higher impact strength than either the polycarbonate or the polyester resin (page 4, lines 8 – 10). As pointed out by the Examiner, Hoefflin does not teach or disclose the use of antistatic agents (Office Action dated 03/29/2005, page 3). While Hoefflin discloses that fillers can be used in the miscible resin, it does not teach that fillers having a refractive index similar to that of the miscible blend can be used (page 21, line 25 – page 22, line 3).

As noted above, Hoefflin does not teach antistatic agents. Hoefflin, further does not teach refractive index matching of the antistatic agent with the polyester-polycarbonate blend. Hoefflin therefore does not disclose all elements of the claimed invention. Since Hoefflin does not teach refractive index matching, one of ordinary skill would not be motivated to add an antistatic agent having a refractive index similar to the polyester-polycarbonate blend.

One of ordinary skill upon reading Hoefflin would be demotivated from combining it with other references such as Kido or Kolycheck, since Hoefflin's teachings are directed to improving the high impact strength of the miscible blends and to maintaining the transparency of the blends. For example, Hoefflin teaches that "[A]lthough polycarbonates exhibit high impact strength, it is desirable to obtain even higher impact strength" (see page 1, lines 13 – 14). Hoefflin further discloses that "[W]hen considering mixtures, blends and additives to polycarbonate, it is difficult to obtain an improvement of one property without deleteriously affecting other desirable properties" (see page 1, lines 14 – 17). One of ordinary skill reading these admonitions would be dissuaded from adding antistatic agents to the miscible blend of Hoefflin, since such additions would degrade the impact and reduce the transparency beyond that desired by Hoefflin. Table 1 and Table 2 of the present application clearly show that impact strength and transparency are reduced when antistatic agents are added to the polyester-polycarbonate miscible blend, which is not what was desired by Hoefflin.

In addition, while Hoefflin discloses that the miscible blends can encompass

Case No. 130237-2

cycloaliphatic polyester-polycarbonate weight ratios of 2 to 1.6, the successful results obtained when an antistatic composition is blended with miscible blends having the aforementioned weight ratios are unexpected. In short, when the teachings of Hoefflin are combined with those of either Kido or Kolycheck there is no expectation of success as embodied in the results shown in Table 1 and 2 of the present application or Table 1 of the Declaration. Table 1 and 2 clearly show that haze is substantially reduced when the antistatic agents are added to the miscible blends having cycloaliphatic polyester-polycarbonate weight ratios of 2 to 1.6. The heat distortion temperature results for this weight ratio range are also superior to other weight ratios of cycloaliphatic polyester-polycarbonate. In this regard, the courts have stated that "[T]he requirement for a determination of obviousness is that 'both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure' (emphasis added). *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

In summary, since Hoefflin teaches away from the combination with Kido or Kolycheck and since there is no expectation of success in combining Hoefflin with either Kido or Kolycheck, Applicants respectfully request withdrawal of the § 103 rejection and an allowance of the claims.

Gaggar

Gaggar teaches polycarbonate-cycloaliphatic polyester blends that contain impact modifiers and special-effect colorants (see Abstract; see page 1, lines 4 – 6). Gaggar, like Hoefflin, does not teach the use of antistatic agents and further does not teach refractive index matching of the antistatic agent with the polyester-polycarbonate blend. Gaggar therefore does not teach all elements of the claimed invention.

Gaggar, however, like Hoefflin, discloses a composition wherein it is desirable to have low temperature impact and high transparency at the same time (see page 2, lines 6 – 7). One of ordinary skill in the art upon reading Gaggar would find no motivation to combine it with either Kido or Kolycheck since Gaggar is directed to compositions that contain impact modifiers for purposes of obtaining low temperature impact strength. Gaggar does not even suggest antistatic compositions. In this regard the courts have held that "[E]ven assuming that

Case No. 130237-2

all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done". *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993).

Further, combining Gaggar with Kido or Kolycheck provides no expectation of success. Even though Gaggar teaches weight ratios of cycloaliphatic polyester to polycarbonate that fall in the range of 2 to 1.6, there is no indication in either Gaggar or Kido or Kolycheck that the combination of antistatic agents with cycloaliphatic polyester and polycarbonate will produce superior results when the weight ratio of cycloaliphatic polyester to polycarbonate is between 2 and 1.6.

In summary, Applicants respectfully request withdrawal of the § 103 rejection over Gaggar in view of Kido and Kolycheck since there is no motivation to combine Gaggar with Kido or Kolycheck and the combination provides no expectation of success.

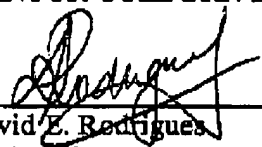
Case No. 130237-2

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-2341 maintained by Cantor Colburn LLP.

Respectfully submitted,

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